

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENTEE :	Merck HDAC Research, LLC	CONFIRMATION NO. :	8627
SERIAL NUMBER :	10/600,132	EXAMINER :	Valenrod
FILING DATE :	June 19, 2003	ART UNIT :	1621
PATENT NO. :	7,456,219	ISSUE DATE :	November 25, 2008
FOR :	POLYMORPHS OF SUBEROYLANILIDEHYDROXAMIC ACID		

Via EFS

RESPONSE TO DECISION ON REQUEST FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT

This response is submitted in response to a Decision on Request for Reconsideration of Patent Term Adjustment and Notice of Intent to Issue Certificate of Correction (the "Decision") mailed May 4, 2010 by the Office. The deadline for responding to the Decision is on or before June 4, 2010.

The Decision states that Patentee is awarded 1447 days of PTA (821 days of A delay + 890 days of B delay - 169 days of overlap - 95 days of applicant delay). Patentee disagrees with the USPTO determination of 95 days of Applicant delay and asserts that this period should instead be 74 days. The Decision states that the period of reduction of 21 days attributed to the filing of the Information Disclosure Statement filed September 18, 2008 (the "IDS"), after the mailing of the Notice of Allowance, will remain. Patentee disagrees.

The Decision acknowledges that the IDS was accompanied by the following statement:

Applicants hereby certify, as specified in 37 C.F.R. §1.97(e), that the item of information contained in this Supplemental Information Disclosure Statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than thirty (30) days prior to the filing of this Supplemental Statement.

It is undisputed that the IDS was, in fact, filed within 30 days of receipt of the information in the IDS from a foreign patent office and the factual circumstances of the IDS filing within the 30 day period alone warrants the withdrawal of the 21 day rejection.

Nevertheless, the Office maintains its position that a reduction of patent term is proper because “Applicants should have mirrored the language as required by 37 CFR 1.704(d)” and further that “patentee has still not provided the Office with a statement mirroring the language set forth in § 1.704(d) with the present renewed petition or to date.” Decision at p. 3. Patentee maintains that it is improper to require verbatim adherence to the language of Section 1.704(d) in making a statement in compliance with that Section.

However, to comply with the requirements of the Decision, Patentee hereby certifies that each item of information contained in the information disclosure statement filed on September 18, 2008 was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement.

In view of the statement which accompanied the IDS filed on September 18, 2008 and the statement made above, Patentee requests reconsideration and withdrawal of the decision to maintain the 21 days of patent term reduction that was attributed to the filing of the IDS. Accordingly, Patentee renews its request that the patent term adjustment be corrected to 1468 days (821 days of A delay + 890 days of B delay – 169 days of overlap – 74 days of applicant delay).

Patentee believes that no fee is required for this submission. However, if any fee is required, please charge the required fee, and any additional fees due, or credit any overpayment of same, to Deposit Account No. 50-0311, Customer No. 30623, Reference No.: 24852-501 CIP.

Respectfully submitted,



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Date: May 27, 2010